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1631

ELX-5795L-6 (BXTD 9006.3)

PATENT

#7/R.T. 6/6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Jerry S. Powell Art Unit 1631
Serial No. 09/975,063
Filed October 10, 2001
Confirmation No. 2666
For METHOD OF MAKING GLYCOPROTEIN EXHIBITING ERYTHROPOIESIS REGULATING ACTIVITY AND GLYCOPROTEIN PRODUCED BY THIS METHOD
Examiner: James Martinell

June 2, 2003

RESPONSE TO RESTRICTION REQUIREMENT

TO THE ASSISTANT COMMISSIONER FOR PATENTS,

SIR:

This letter is in response to the Office action of May 2, 2003, in which an election as between the following groups of claims for prosecution on the merits was requested: Group I (claims 10-33) drawn to methods for expressing recombinant erythropoietin; Group II (claims 34-39) drawn to erythropoietin produced by the method of the Group I claims.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. Furthermore, "[i]f the search and examination of an entire application can be made **without serious burden**, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."[1]

In this case, restriction is not proper. The claims of Group I are directed toward a method of making recombinant erythropoietin and the claims of Group II are drawn to the recombinant erythropoietin produced by the method of the Group I claims. Because the Group I and Group II claims contain a common recited element, a method for

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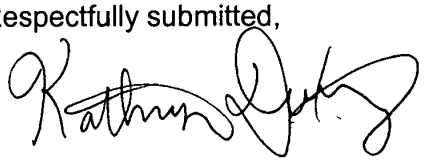
[1] MPEP § 803 (emphasis added).

producing recombinant erythropoietin, any search of the prior art and examination involving the Group I claims, therefore, will necessarily co-extend with the search and examination of the Group II claims. Moreover, the claims in this case are limited to the **Apa I restriction fragment** of the human erythropoietin gene, as opposed to the whole gene. The prior art regarding Apa I restriction fragments of the human erythropoietin gene is sufficiently sparse to allow the examination of these claims without undue burden. Since the examination of the entire application may be made without serious burden, the claims of Groups I and II should be examined together in accordance with MPEP § 803.

Applicant, subject to the foregoing traverse, hereby elects to prosecute the claims of Group I, claims 10-33, drawn to methods for expressing recombinant erythropoietin.

Applicant reserves the right to file divisional applications directed to the subject matter of the non-elected claims.

Respectfully submitted,



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